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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,538	10/30/2001	Raymond Ho	6735-01	5679

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McCormick, Paulding & Huber
City Place II
185 Asylum Street
Hartford, CT 06103-3402

EXAMINER

GREENE, DANIEL L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,538

Applicant(s)

HO ET AL.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/22/2004 have been fully considered but they are not persuasive. The Applicant's Amendments though extensive do not render the Application unique, original or non-obvious. The Applicant has an identifier associated with the software application to enable the use of the software. The primary reference, Folmsbee, presents that concept in Col. 1, lines 45-50, where he states, " In other cases, the software can be freely copied, so that piracy restrictions are accomplished either by end user agreement or by simple techniques such as the requirement to use a product serial number to enable use of the software." Folmsbee goes on to expand the use of other serial numbers in Col. 1, lines 55-60, when he states, "... it is possible to provide a serial number which can be read out by the end user during execution with appropriate instructions." The concept of using an identifier from a specific computer system to limit the use of the software to just that specific computer system is obvious and well known to a person of ordinary skill in the art at the time of the invention and disclosed by Folmsbee. A reference is to be considered not only for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Folmsbee U.S. Patent 6,308,256 [Folmsbee], and further in view of Hirsch U.S. Patent 5,276,738 [Hirsch]

3. As per claims 1, 6, and 11:

The recitation that " A method of authenticating, a software application for use on a computer system, and An Article, comprising", has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method, a system, an apparatus, etc. and the portion of the claim following the preamble is a self-contained description of the method or the system, etc., not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)

4. Folmsbee discloses:

5. providing a software application for use on a computer system having an identifier, the software application including an associated engraved signature, the engraved signature being initially blank such that the software application can be authenticated for use on one of a plurality of computer systems. Col. 1, lines 45-60.

6. reading the engraved signature. Col. 14, lines 40-67.

retrieving the identifier from the computer system', Col. 14, lines 40-67.

encrypting the identifier using the encryption method to obtain a computed signature. Col. 14 , lines 40-67.

comparing the computed signature to the engraved signature', Col. 16, lines 1-15.

halting execution of the software application if the computed signature does not match the engraved signature', Col. 19, lines 18-67.

Folmsbee discloses the claimed invention except for storing the computed signature as the engraved signature. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to store the computed signature as the engraved signature since it is known in the art that after an identifier for a computer system has been created for use with the software application to be used on the specific computer system, the computed signature is stored for future use.

PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed language "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In these pending claims, the examiner submits that particular language does not serve as a limitation on the claim (i.e., "engraved signature"). Based upon the information provided, an engraved signature is effectively a computer system identifier that has been encrypted and stored for use as a key to validate that the same computer system is being used. Folmsbee teaches such a techniques as per the section on Serial Number Utilization. Col. 14.

Folmsbee discloses the claimed invention except for the serial number being a CPU serial number. Hirsch teaches that it is known in the art to provide a CPU serial

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number for verification techniques. Col. 8, lines 1-30. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the Serial Number Utilization of Folmsbee with the CPU serial number utilization of Hirsch, in order to insure only the CPU whose serial number is in the key is being used.

As per claims 2, 7, and 12:

Folmsbee does not expressly show wherein the encryption method is called Block Cipher SQUARE. However, Folmsbee does teach about the use of one-way algorithms. Col. 18, lines 48-67. The type of method used, does not appear to be the non-obvious, original invention presented. In fact, the Examiner submits that any type of method could be used for the encryption function of the invention and not deter or distract from the concept or intent of the invention.

The encryption steps would be performed the same regardless of the method used. Thus, the type of method used will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use any type of method to encrypt data, because the type of method used does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claims 3, 8, and 13:

Folmsbee discloses the claimed invention except for the step of decrypting the engraved signature before comparing with the computed signature where the engraved signature has been encrypted.

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have the step of decrypting the engraved signature before comparing with the computed signature where the engraved signature has been encrypted since it is known in the art that the storage of verification keys is normally done with the keys being encrypted to prevent hackers inadvertently getting the serial numbers being used by the system.

As per claims 4, 9, and 14:

Folmsbee discloses the claimed invention except for wherein the step of decrypting the engraved signature includes using another encryption method.

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to wherein the engraved signature has been encrypted and decrypted using another method, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As per claims 5, 10, and 15:

Folmsbee discloses the claimed invention except for the wherein the identifier comprises at least one of a MAC address of a Network Interface Card, a serial number of a CPU: a hard drive format code number, and a code number of computer system "add-ons'.

Hirsch teaches that it is known in the art to provide a wherein the identifier comprises at least one of a MAC address of a Network Interface Card, a serial number of a CPU: a hard drive format code number, and a code number of computer system "add-ons'. Col. 8, lines 1-20.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the Serial Number Utilization of Folmsbee with the CPU serial number utilization of Hirsch, in order to insure only the CPU whose serial number is in the key is being used.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

1/26/2005


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Daniel L. Greene
Examiner
Art Unit 3621